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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

AMAKWE, TAMRA L

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMINARI ARAKI,
MASANORI NAKANO, KIHACHI SAKAIDA,
and KOUICHI KANNO

Appeal 2010-001381
Application 10/056,973
Technology Center 1700

Decided: April 30, 2010

Before CHUNG K. PAK, CHARLES F. WARREN, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER DISMISSING APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 10 through 51 in the Office Action mailed September 21, 2005. The Examiner refused to allow claims 10 through 12,

14 through 31, and 33 through 51 as subsequently amended, claims 13 and 33 having been cancelled. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2005).

The record shows that a prior merits panel entered a Remand To the Examiner in this Application requiring the Examiner to obtain an authoritative translation of Japanese patent document JP 9-176586 and further consider the grounds of rejection advanced on appeal in light of, among other things, the authoritative translation. Rem. 4. The Japanese patent document JP 9-176586 was submitted with the Information Disclosure Statement filed October 25, 2007, subsequent to the filing of the Reply Brief on March 22, 2007.

The Remand further required that if the Examiner submitted a Supplemental Answer in response to the Remand, Appellants must comply with 37 C.F.R. §41.50(a)(2) (2007), which states that “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth “in order to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding.” Rem. 4. Under 37 C.F.R. §§ 41.50(a)(2)(i) and (ii), Appellants’ two options are to “[r]equest that prosecution be reopened before the examiner by filing a reply under § 1.111,” and to “[r]equest that the appeal be maintained by filing a reply brief as provided in § 41.41.” *See* Manual of Patent Examining Procedure (MPEP) §§ 1207.02 and 1121.01 (Rev. 3, August 2005).

In the Supplemental Answer mailed February 22, 2008, the Examiner supplied and relied on a translation of Japanese patent document

JP 9-176586 to Miura in setting forth two new grounds of rejection under 35 U.S.C. § 103(a), while maintaining the two grounds of rejection under 35 U.S.C. § 103(a) advanced in the Answer:¹

claims 10 through 12, 14 through 21, 25 through 32, 34 through 40, and 44 through 51 over Koike in view of Berler;

claims 22 through 24 and 41 through 43 as unpatentable over Koike in view of Berler, further in view of Mochizuki;

claims 10 through 12, 14 through 21, 25 through 32, 34 through 40, and 44 through 51 as unpatentable over Koike in view of Miura; and

claims 22 through 24 and 41 through 43 as unpatentable over Koike in view of Miura, further in view of Mochizuki.

Supp. Ans. 2, 3, 6, 7, and 9; *see* App. Br. 3; Ans. 3 and 5.

On this record, we find the Examiner considered the two grounds of rejection, which encompassed all appealed claims, advanced in the Answer and in substance modified both grounds by relying on Miura instead of Berler in the Supplemental Answer to further reject all of the appealed claims even though the two grounds of rejection advanced in the Answer were maintained in the Supplemental Answer.

The record further shows that the Examiner specifically identified the two grounds of rejection including Miura as new grounds of rejection in the Supplemental Answer, and a Technical Center Director Designee signed the Supplemental Answer. Ans. 2, 7, and 12. Thus, Appellants had ample notice of the new grounds of rejection and thus, that a reply was due pursuant to 37 C.F.R. §§ 41.39(b) even though the Supplemental Answer did

¹ The listing of claims in these grounds reflects cancellation of claims 13 and 33. *See above* p. 2.

not set a two month time period for a reply as specified in that rule. *See* MPEP § 1207.03(Rev. 3, August 2005).

Therefore, it is clear on the record that in order to continue prosecution of this Application, Appellants had to file a reply as specified in 37 C.F.R. §§ 41.39(b) and 41.50(a)(2). Indeed, the two options for a proper reply in order to avoid sua sponte dismissal of the appeal as to the subject claims are the same in each of these rules. *Cf.* MPEP § 1207.02 with MPEP § 1121.01 (Rev. 3, August 2005).

The record does not reflect that Appellants filed a reply to the Supplemental Answer.

Accordingly, because Appellants did not file a reply and the maintained and new grounds of rejection encompass all appealed claims, it is

ORDERED that the Appeal filed April 24, 2006, is dismissed.

This Application is being returned to the Examiner, via the Office of a Director of the Technology Center, for further action as may be appropriate.

DISMISSED

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036